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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,216	08/28/2003	William F. Nordlin	913/38560A	7134
279	7590	06/21/2004	EXAMINER	
Trexler, Bushnell, Giangiorgi, Blackstone & Marr, Ltd. 105 West Adams Street Suite 3600 Chicago, IL 60603			PETERSON, KENNETH E	
			ART UNIT	PAPER NUMBER
			3724	
DATE MAILED: 06/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,216

Applicant(s)

NORDLIN

Examiner

Kenneth E Peterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 13, 23, 24 and 27-39 is/are pending in the application.
- 4a) Of the above claim(s) 23, 24 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 27-32 and 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 19dec03, 28aug03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 23,24,33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made without traverse in the paper received 11 May 04.

2. All of the claims are objected to because of the following informality:

All of the claims require that the first jaw be fixed to a handle. In fact, the first jaw is connected to the handle 38 at just one pivot point (98), and thus is not "fixed" to the handle. To correct this, Applicant need merely change "fixed" to --attached--.

Appropriate correction is required.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 12,13,27-32,34-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/079,089. Examiner was unable to get a copy of the claims of 10/079,089 due to it being at the publishing division. However, from the

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Examiner's recollection, the claims are not patentably distinct from each other because they recite the same subject matter. Assuming Applicant has a copy of the claims of 10/079,089, Applicant would have an opportunity to refute Examiner's position. Examiner will have a copy of these claims as soon as 10/079,089 issues and will re-judge the situation at that time.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented (altho they have been allowed).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 30 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Neal '263, who shows in figure 4 a cutter with all of the recited limitations including a holding pawl (26') and a second pawl advancing means (speed pawl 419) that is spring biased (35) and advances the blade when the handles (12,34) are moving away from each other. The second pawl advancing means is "configured" to idle when resistance is met by having a lever (36) that positions the second pawl (419) to idle. The second pawl (419) has a pin (56) that rides in a slot (55) of a "component" (54) on the second handle (12).

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12,13,27-32 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neal '263 in view of Osborn.

Neal, as set forth above, shows a cutter having all of the recited limitations except a third pawl that drives when the handles are moved toward one another. However, it is well known in the art of cutting to have an additional pawl for driving when the drive handle moves the other way, as seen in Osborn (35). It would have been obvious to one of ordinary skill in the art to have added an additional engagement pawl to Neal's handle that drives the tool in the same direction when the handle move the other way, as taught by Osborn, in order to use the energy of the operator more efficiently by extracting motion from both the forward and backward motion of the lever.

Applicant's functional recitations of resistance from the workpiece and differing advancement when differing handle motion have been met since Neal, as modified, is *capable* of stopping when resistance is met, and is *capable* of having a three-to-one tooth advancement ratio by simply moving the handle more in one direction than the other.

In regards to claim 13, each of Neal's pawls has just one tooth, rather than having *teeth*. However, Examiner takes Official Notice that it is well known for this type of apparatus to have pawls with multiple teeth. An example of such is Beetz et al.'570.

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Of course, there are "indents" between the teeth. It would have been obvious to one of ordinary skill in the art to have further modified Neal by making each of the pawls have multiple teeth and indents, as is well known and shown by Beetz, in order to better grip the geared jaw.

9. Made of record but not relied on is a patent to Wintemute showing a gear actuated cutter, and a Japanese patent showing a ratchet actuated cutter.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday thru Thursday between 7am and 4pm.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

kp
June 18, 2004



KENNETH E. PETERSON
PRIMARY EXAMINER